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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,197	06/01/2006	Takao Hasegawa	040894-7453	2328

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MORGAN LEWIS & BOCKIUS LLP
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WASHINGTON, DC 20004

EXAMINER

SMITH, SCOTT A

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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11/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,197	Applicant(s) HASEGAWA ET AL.	
	Examiner Scott A. Smith	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 3-13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The request for consideration filed on 6/30/09 has been entered and the remarks therein have been considered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite since its scope is unclear. Since the body of the claim, as previously amended, includes considerable particulars of the rolled staple cartridge, it is unclear as to whether a combination of a stapler and a cartridge is being claimed, or merely a stapler, which could be used with the recited cartridge of staples, if desired. Thus, the meets and bounds of the claims are indefinite since it unclear as to whether particulars of the staple roll and its relationship to the stapler, is the subject matter being sought for patentability. Currently, claim 1 is directed to a stapler in the preamble. If the claims were amended to recite a combination of a stapler and a staple cartridge in the preamble, for example, they could constitute a patentably distinct invention, than is currently set forth.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Udagawa et al. '529.

Udagawa et al. '529 discloses a stapling apparatus comprising a feeding roller 43 driven by suitable drive mechanism; i.e. a "motor" (note: column 4, lines 60-65) for advancing a straight staple of a coil of staples (note: Fig. 9) which are accommodated in a holder/cartridge to a stapling location. The particulars of the contact location between the rolled staple cartridge and the feed roller are not given any patentably weight since only a stapler is claimed, not a combination of a stapler and cartridge, per se. Udagawa et al. '529 discloses the claimed structure of the stapler including a motor and a feeding roller.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa et al. '529.

In the event that the stapler of Udagawa et al. '529 is interpreted not include the invention as claimed; i.e. the contact location of the feed roller relative to the rolled staple cartridge periphery, it would have been obvious to one skilled in the art to form

the stapler of Udagawa et al. '529 such that the feed roller contacts an "outer circumference" of the rolled staple cartridge in order to consolidate the device and more effectively support the rolled staple cartridge.

Additionally, applicant is given Official Notice that to locate a feed roller in contact with an outer circumferential peripheral surface of a rolled material/cartridge is known. Therefore, in view of such Official Notice, it would have been obvious to one skilled in the art to form the stapler of Udagawa et al. '529 such that the feed roller contacts an "outer circumference" of the rolled staple cartridge in order to consolidate the device and more effectively support the rolled staple cartridge during delivery.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Udagawa et al. '529 in view of German Patent '519 or Hoshi et al. '334.

Udagawa et al. '529 lacks the feed roller having feed teeth. German patent '519, as set forth above, discloses a feeding roller comprising teeth "d". Hoshi et al. '334 discloses a feeding roller 50 comprising a plurality of teeth thereon (note: Fig. 10). In view of the teachings of German patent '519 or Hoshi et al. '334, it would have been obvious to one skilled in the art to provide the periphery of the feeding roller of the stapler of Udagawa et al. '529 with a plurality of teeth in order to more effectively register and retain the staple coil during operation.

Response to Arguments

8. Applicant's arguments filed on 6/30/09 have been fully considered but they are not persuasive. Applicants argue that the claims are clear and definite. Although the

claims may be clear, it is the Examiner's position that their scope is unclear since the meets and bounds of the claims, as set forth above, is in question.

Applicants argue that the roller of Udagawa fails to feed a wound portion. As set forth above it is the Examiner's position that the feed roller of Udagawa "could" be utilized on wound staples, especially in light of Fig. 9 which discloses that to utilize a wound staple supply in the stapler is known.

Allowable Subject Matter

9. Claim 14 is allowed.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith

/Scott A. Smith/
Primary Examiner, Art Unit 3721